

**REMARKS UNDER 37 CFR § 1.111**

**Formal Matters**

Claims 13-38 are pending after entry of the amendments set forth herein.

Claims 13-36 were examined. Claims 13-17, 19-21 and 24-36 were rejected. Claims 18, 22 and 23 were objected to as depending from a rejected base claim but containing allowable subject matter.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

**The Office Action**

**Claims Rejected Under Non-Statutory Obviousness-Type Double Patenting – Benetti et al. ‘556 in view of Nicholas et al.**

In the Official Action of March 30, 2006, claims 13,24-28,31-34 and 36 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 8-20 of Benetti et al., U.S. Patent No. 6,199,556 in view of Nicholas et al., U.S. Patent No. 5,967,974. The Examiner asserted that the claims of Benetti et al. disclose all the limitations of the rejected claims except for the main body remaining resting against the frontal body of the patient. The Examiner further asserted that Nicholas et al. teaches the use of a surgical retractor having a main body or retractor that remains resting (at least partially) against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting a least a portion of the ribs of the patient, and that it would have been obvious to modify the device of Benetti et al. with the teaching of Nicholas et al. to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Applicants respectfully disagree. Nicholas et al. discloses a surgical retractor that is configured to create an opening between an adjacent pair of ribs. As noted at column 4, lines 61-65, in the case of heart surgery, the retractor hooks 132 and 112 are inserted between the fourth and fifth ribs so that hook portion 132 biases against a first of these ribs and hook portion 112 biases against a second of these ribs in opposite directions. In this position, the retractor frame 112 (sic, 110) is substantially parallel to the

ribs. Adjustment knob 128 is then turned to retract hook portion 132 away from hook portion 112 until the desired opening is achieved between the adjacent ribs. Applicants note that at this stage of the procedure, neither rib is lifted, as they are just laterally separated. Next, the outwardly extending portion 118 of frame 110 is elevated by raising end 118 so as to elevate one side of the retractor.

In contrast, the lifting arm 13 of Benetti et al is articulated with respect to the main frame of the retractor. Accordingly, there is no need to lift a portion of the main frame of the retractor to effect lifting of the ribs, as lifting arm is raised while maintaining the main frame of the retractor in contact against the skin of the patient. It is respectfully submitted that one of ordinary skill in the art would not have been motivated to elevate a portion of the main frame of Benetti et al. out of contact with the patient's body in order to effect lifting of the ribs, as this would be completely unnecessary and cumbersome, and is in conflict with the manner in which the device is designed to operate.

Further, Applicants have amended claim 13 above to further recite that the lifting arm is adapted to engage a lowermost rib of the patient in order to perform the lifting. It is respectfully submitted that the hook member 126 of Nicholas et al. is not adapted to engage a lowermost rib of a patient in order to effect lifting of a least a portion of the ribs of the patient, as there would be no rib for hook portion 112 to engage against.

Claim 31 has been amended to further recite that the retractor is configured to rest against the frontal body of the patient by contacting the frontal body at a location over the ribs and at a location inferior to the ribs. It is respectfully submitted that the device of Nicholas et al. is not configured to rest against the patient both against the ribs and at a location inferior to the ribs.'

In view of the above remarks and the amendments to the claims, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13,24-28,31-34 and 36 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 8-20 of Benetti et al., U.S. Patent No. 6,199,556 in view of Nicholas et al., U.S. Patent No. 5,967,974, as being inappropriate.

**Claims Rejected Under Non-Statutory Obviousness-Type Double Patenting – Benetti et al. '774 in view of Nicholas et al.**

Claims 13,24-28,31-34 and 36 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-13 of Benetti et al., U.S. Patent No. 6,736,774 in view of Nicholas et al., U.S. Patent No. 5,967,974. The Examiner asserted that the claims of Benetti et

al. disclose all the limitations of the rejected claims except for the main body remaining resting against the frontal body of the patient. The Examiner further asserted that Nicholas et al. teaches the use of a surgical retractor having a main body or retractor that remains resting (at least partially) against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting a least a portion of the ribs of the patient, and that it would have been obvious to modify the device of Benetti et al. with the teaching of Nicholas et al. to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Applicants respectfully disagree. Nicholas et al. discloses a surgical retractor that is configured to create an opening between an adjacent pair of ribs. As noted at column 4, lines 61-65, in the case of heart surgery, the retractor hooks 132 and 112 are inserted between the fourth and fifth ribs so that hook portion 132 biases against a first of these ribs and hook portion 112 biases against a second of these ribs in opposite directions. In this position, the retractor frame 112 (sic, 110) is substantially parallel to the ribs. Adjustment knob 128 is then turned to retract hook portion 132 away from hook portion 112 until the desired opening is achieved between the adjacent ribs. Applicants note that at this stage of the procedure, neither rib is lifted, as they are just laterally separated. Next, the outwardly extending portion 118 of frame 110 is elevated by raising end 118 so as to elevate one side of the retractor.

In contrast, the lifting arm 13 of Benetti et al. '774 is articulated with respect to the main frame of the retractor. Accordingly, there is no need to lift a portion of the main frame of the retractor to effect lifting of the ribs, as lifting arm is raised while maintaining the main frame of the retractor in contact against the skin of the patient. It is respectfully submitted that one of ordinary skill in the art would not have been motivated to elevate a portion of the main frame of Benetti et al. '774 out of contact with the patient's body in order to effect lifting of the ribs, as this would be completely unnecessary and cumbersome, and is in conflict with the manner in which the device is designed to operate.

Further, Applicants have amended claim 13 above to further recite that the lifting arm is adapted to engage a lowermost rib of the patient in order to perform the lifting. It is respectfully submitted that the hook member 126 of Nicholas et al. is not adapted to engage a lowermost rib of a patient in order to effect lifting of a least a portion of the ribs of the patient, as there would be no rib for hook portion 112 to engage against.

Claim 31 has been amended to further recite that the retractor is configured to rest against the frontal body of the patient by contacting the frontal body at a location over the ribs and at a location inferior to the ribs. It is respectfully submitted that the device of Nicholas et al. is not configured to rest against the patient both against the ribs and at a location inferior to the ribs.

In view of the above remarks and the amendments to the claims, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13,24-28,31-34 and 36 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-13 of Benetti et al., U.S. Patent No. 6,736,774 in view of Nicholas et al., U.S. Patent No. 5,967,974, as being inappropriate.

**Claims Rejected Under 35 U.S.C. Section 102(e) – Nicholas et al.**

Claims 13-17, 19-21, 31 and 26 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Nicholas et al., U.S. Patent No. 5,967,974. With regard to claims 12 (sic, 13) and 31, the Examiner asserted that Nicholas et al. discloses a surgical apparatus for accessing a beating heart, wherein the apparatus comprises a main body 10 configured to rest against the frontal body of a patient, a lifting arm 126 movable mounted to the main body and adapted to engage and lift at least a portion of the ribs of the patient, while the body or retractor remains resting against the front body of the patient.

As noted above, claim 13 has been amended above to further recite that the lifting arm is adapted to engage a lowermost rib of the patient in order to perform the lifting. It is respectfully submitted that the hook member 126 of Nicholas et al. is not adapted to engage a lowermost rib of a patient in order to effect lifting of a least a portion of the ribs of the patient, as there would be no rib for hook portion 112 to engage against.

Claim 31 has been amended to further recite that the retractor is configured to rest against the frontal body of the patient by contacting the frontal body at a location over the ribs and at a location inferior to the ribs. It is respectfully submitted that the device of Nicholas et al. is not configured to rest against the patient both against the ribs and at a location inferior to the ribs.

In view of the above remarks and the amendments to the claims, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13-17, 19-21, 31 and 26 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Nicholas et al., U.S. Patent No. 5,967,974, as being inappropriate.

**Claims Rejected Under 35 U.S.C. Section 103 – Nicholas et al. in view of Asrican**

Claims 29 and 30 were rejected under 35 U.S.C. Section 103 as being unpatentable over Nicholas et al., U.S. Patent No. 5,967,974 in view of Asrican, U.S. Patent No. 3,680,546. The Examiner

admitted that Nicholas et al. does not disclose use of a fiber optic light. However, the Examiner asserted that it would have been obvious to modify the device of Nicholas et al. to use a fiber optic light as taught by Asrican, in order to server to direct the direction of light in the chest cavity.

Applicants respectfully submit that Asrican fails to teach or disclose those features that are lacking in the Nicholas et al. device to meet all of the recitations of claim 13, as indicated above. Accordingly, it is respectfully submitted that even if this combination of reference teachings would have been proper, which Applicants do not necessarily agree that the suggested combination is proper, the result would still fail to meet all of the recitations of claim 13. Since claims 29 and 30 depend from claim 13, it is respectfully submitted that claims 29 and 30 are also allowable over the suggested combination of references.

In view of the above remarks and the amendments to the claims, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 29 and 30 under 35 U.S.C. Section 103 as being unpatentable over Nicholas et al., U.S. Patent No. 5,967,974 in view of Asrican, U.S. Patent No. 3,680,546, as being inappropriate.

#### **Claims Objected To**

Claims 18, 22 and 23 were objected to as being dependent upon a rejected base claim. However, the Examiner indicated that these claims would be allowable if rewritten into independent form to include all of the limitations of the base claim and any intervening claims. In response thereto, Applicants have submitted new claims 37 and 38 above. New claim 37 combines the recitations of claim 13 (prior to the above amendment of claim 13), 17 and 18. New claim 38 combines the recitations of claim 13 (prior to the above amendment of claim 13), 17 and 22. Accordingly, the Examiner is respectfully requested to indicate the allowance of claims 37 and 38 in the next Official Action.

#### **Conclusion**


Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-008CON2.

Respectfully submitted,

LAW OFFICE OF ALAN W. CANNON

Date: 6/25/06

By:   
Alan W. Cannon  
Registration No. 34,977

LAW OFFICE OF ALAN W. CANNON  
834 South Wolfe Road  
Sunnyvale, CA 94086  
Telephone: (408) 736-3554  
Facsimile: (408) 736-3564